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| 10/706,311 | 11/12/2003 | Ken Rosenblum | 1326.007US1 | 9674 |
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| SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402 | | | SHAPIRO, JEFFERY A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3653 | |

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,311

Applicant(s)

ROSENBLUM, KEN

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 32 recites the limitation "filled prescription" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Also, in line 8, the word "and" appears to be extraneous.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Bain (US 2005/0021175A1).

As described in **Claims 1-3, 5, 6, 13-17, 19-21, 23, 24, 28, 29 and 31**, Bain discloses an automatic medication dispensing machine (100) having a loading portion facing an enclosed pharmacy floor space, as shown in figure 2, the pharmacy, being to

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the right of wall (104). Service providers on the right side place filled prescriptions into compartments (152) which are closed by doors (166). A customer keys in a PIN number and phone number at the front console data interface (124) which is mentioned in paragraph 60 as having a keyboard. See also paragraph 111. If the phone number and PIN are verified, and the customer verifies the order listed on the screen, then the dispensing mechanism releases the filled prescription through door (158) to pick up area (140).

Bain further discloses, as described in **Claim 4**, a bar code reader (78).

Bain also discloses, as described in **Claims 7, 8, 18, 25 and 26**, a speaker (32) and a video device described in paragraphs 20 and 43.

Regarding **Claim 9**, Bain discloses a remote communications means (86) that is described in paragraphs 52-58 that allows delivery of a filled prescription to a customer located outside the store.

Regarding **Claims 10, 27 and 30**, see paragraph 111, which describes the financial transaction that takes place during a dispensing event.

Regarding **Claim 11**, Bain discloses a dispensing mechanism (100), a product delivery chute having a product holding portion (152) and a product holding portion (140) separated by moving door (158).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bain in view of Coughlin et al (US 6,883,681 B1).

Bain discloses the drug will-call system described above.

Williams does not expressly disclose, but with respect to Claim 22, Coughlin discloses shelf storage locations (16) with an infeed conveyor (18) and an outfeed conveyor (21) with a pick and place transporter (22 and 126) that transports items between the storage locations and the infeed and outfeed conveyors.

Williams does not expressly disclose, but with respect to Claim 12, Coughlin discloses a ram assembly (90) for pushing products from the infeed conveyor to the transporter, said ram assembly having a sensor (100) that senses when product has been conveyed in front of the ram plate (92). See figures 8-12 and col. 6, lines 16-33. Coughlin also discloses a ram assembly (118) which moves items onto outfeed belt (110). See figures 13-17 and col. 6, line 35-col. 7, line 12.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added Coughlin's transporter to transport items from Bain's storage areas to Bains dispensing area and to have incorporated Coughlin's conveyor with ram assembly into Bain's dispensing area. to push items to and from the conveyor to the transporter or vise-versa.

The suggestion/motivation for using Coughlin's transporter would have been to transport items efficiently to and from Bain's storage areas to the dispensing area. The suggestion/motivation for using Coughlin's conveyor with ram assembly in Bain's

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dispensing area would have been to push items back and forth from the conveyor to the transporter.

Note that one ordinarily skilled in the art would have found it obvious to use a time out based on the output of sensor (100), for example, thus causing ram assembly (90) to clear the dispensed items from the dispensing area, as suggested by Coughlin's ram assemblies (90) and (118).

Also, note that one ordinarily skilled would have found it obvious to make Bain's compartments more horizontal so as to work with Coughlin's transporter.

See also Coughlin at col. 13, lines 1-5, which describes the infeed conveyor moving several items back from the ram leaving only one item in front of the ram during a particular event, such as receiving a command to load an item during a storing routine. This can be construed as further motivation for one ordinarily skilled to cause items left on the outfeed dispensing conveyor to be cleared and restored in one of the storage compartments.

8. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hart et al (US 7,006,893 B2) in view of Bain.

Hart discloses incorporating several different drug vending machines in a network (320) or (9010), one machine (20, 124, 130, 132, 182, 324, 582 or 9044) dispensing prescription drugs in containers already labeled (see figure 1a, for example), the other machine (1650) dispensing drugs in containers that have been automatically

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labeled by the vending machine itself. See Hart, figures 35, 36 and 110a and col. 46, line 10- col. 48, line 28.

Hart does not expressly disclose, but Bain discloses the will-call system described above.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated Bain's will-call system into the network of Hart, having a first will-call vending machine that dispenses drugs in containers that have been pre-labeled and a second vending machine that dispenses drugs in containers that have been labeled by the machine itself.

The suggestion/motivation would have been to incorporate a will-call vending machine, as taught by Bain, which allows patients to pick up prescriptions while the pharmacy is busy or closed, into a network of drug vending machines. See Bain, paragraph 2.

One ordinarily skilled in the art would have been further led to combine Bain with Hart because Hart's system endeavors to "provide a convenient, safe, automated, and low cost drug delivery system..." See Hart, col. 1, line 64-col. 2, line 6 and col. 2, lines 20-23. Bain's system adds to the cost savings and efficiency of Hart's integrated system.

Terminal Disclaimer

9. The terminal disclaimer filed on 8/1/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of (US

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6,892,641) has been reviewed and is accepted. The terminal disclaimer has been recorded.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Denenberg and Jordan are cited as other automated will-call systems.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JAS

October 24, 2006



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